

S/N: 09/456,833

08/09/2002

DOCKET NO.: KAW-215-USAP

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3713

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

SEP 17 2002

PATENT & TRADEMARK OFFICE

In re Application of: Yoshikazu SAKAMOTO, t al.

Serial No.: 09/456,833

Art Unit: 3713

Filed: December 7, 1999

Examiner: J. Hotaling

For: GAMING MACHINE

#18 (Reg. for Recon. (a) / Petition)
h/m/rga-9/24/02

PETITION TO WITHDRAW SECOND FINAL REJECTION

DATED AUGUST 23, 2002

Assistant Commissioner for
Patents & Trademarks
Washington, D.C. 20231

BOX: PETITIONS

Sir:

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SEP 20 2002

TECHNOLOGY CENTER R3700

The Examiner has in the second Final Office Action dated August 23, 2002 for the second time added a completely new rejection of non-amended claims 1, 27 and also claims 28 - 34 (which were presented for the first time on March 18, 2002). This violates MPEP § 706.07(a).

The first rejection was dated July 17, 2001 and was final. Applicant petitioned for withdrawal of the July 17, 2002 rejection without responding to the merits of the rejection based upon new references. Instead, the rejection on new references was petitioned as being in violation of §706.07(a) (see first paragraph, page 1). The petition was considered "persuasive" and granted. The July 17, 2002 final was withdrawn on August 23, 2002 (See paragraph 1). A new final was issued August 23, 2002. The withdrawn Office Action is no longer an Office Action. The first

withdrawn Final Office Action cannot be construed to be a "first action" because it is withdrawn (it does not exist and required no response).

The new final rejection dated August 23, 2002 of claims 1 - 27 is based upon this same prior art cited to the Examiner in an Information Disclosure Statement filed on June 27, 2002 the rejection is also the same. In this Information Disclosure Statement, Applicant submitted art which was newly brought to Applicant's attention by the communication from Europe dated June 6, 2002. The two new references are GB 2,262,642 and EP 0 875 870 A2. Neither of these references were known to Applicant as stated in the Information Disclosure Statement until well after the filing of Applicant's previous amendment on March 18, 2002.

MPEP § 706.07(a) (copy attached) provides that a final rejection is proper only when the new ground of rejection is not necessitated by amendment (there were no amendments in claims 1 - 27) nor based on information submitted in Information Disclosure statement filed during the period set forth in 37 CFR § 1.97(c) with the fee set forth in 37 CFR § 1.17(p). Here, the critical fact is that Applicant filed no fee with the Information Disclosure Statement because applicant was able to certify under 37 CFR § 1.97(e) that the items submitted first became available to Applicant on June 6, 2002. Therefore, it is clearly improper to make this new ground of rejection final.

Applicant has never had an opportunity to respond to a non-final rejection based upon the new references. It is basic that an Applicant must be given one opportunity to respond to a completely new rejection without being under a final rejection, especially when the claims were not changed. This is a reason for MPEP § 706.07(a).

The rejections based upon the newly cited art are new grounds of rejection and were and are under final and, therefore, require withdrawal of the final rejection as required by MPEP § 706.07(a). Two finals do not make a required non-final and two wrongs do not make a right. This second final cannot be justified because there was a first withdrawn final after the persuasive petition was granted.

The proper procedure should have been to make the rejection a new non-final rejection because it is based upon the new art.

Conclusion

Since the first rejection was an improper final rejection, the second final for the same reason is clearly improper. This final rejection must be withdrawn.

Enclosed is a check in the amount of \$130.00 to cover the fee for filing this petition. The Commissioner is hereby authorized to

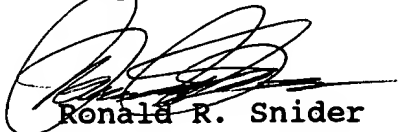
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charge any deficiency or credit any overpayment to Deposit Account
19-2816. A duplicate copy of this Transmittal is attached.

Respectfully submitted,



Ronald R. Snider
Reg. No. 24,962

Date: August 9, 2002

Snider & Associates
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Serial No.: 09/456,833

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Filed: December 7, 1999

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PETITION FOR RETURN OF PETITION FEES
FOR PETITION FILED SEPTEMBER 17, 2002

Assistant Commissioner for
Patents & Trademarks
Washington, D.C. 20231

BOX: PETITIONS

Sir:

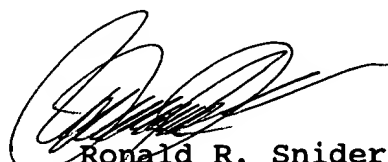
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TECHNOLOGY CENTER R3700

Applicant hereby petitions for return of the petition fee of \$130.00 which was submitted with Applicant's petition filed on September 17, 2002 if this petition is granted.

Respectfully submitted,



Ronald R. Snider
Reg. No. 24,962

Date: August 9, 2002

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